

### **REMARKS**

Claims 1, 2, and 4-28 are pending in this application. Claims 18-24 have been allowed. The Examiner objected to claim 16 as being dependent upon a rejected base claim, but he indicated it would be allowable if rewritten in independent form. The Examiner rejected claims 1, 2, 4-15, 17, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over the primary reference of Montes (U.S. Patent Application Publication No. 2004/0260157) in view of Schwartz (U.S. Pat. No. 6,610,256) or in view of Schwartz and Ortyn et al. (U.S. Pat. No. 6,532,061). In this Response, the Applicant has submitted for the Examiner's consideration an Affidavit under Rule 1.131. The Applicant kindly requests reconsideration and allowance of pending claims 1, 2, 4-17, and 25-28 for the reasons detailed below.

#### **1) Rejection Based on the Primary Reference of Montes:**

The Examiner rejected claims 1, 2, 4-17, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over the primary reference of Montes (U.S. Patent Application Publication No. 2004/0260157) in view of Schwartz (U.S. Pat. No. 6,610,256) or in view of Schwartz and Ortyn et al. (U.S. Pat. No. 6,532,061). Thus, the Montes reference is the primary reference cited by the Examiner in support of the rejection under 35 U.S.C. § 103(a).

In this Response, the Applicant submits for the Examiner's consideration in support of the application's patentability an attachment entitled "Affidavit Under 37 C.F.R. § 1.131". The Applicant respectfully suggests that this attachment establishes invention of the subject matter of the rejected claims in the United States of America before the effective date of the cited primary reference (the Montes reference) on which the rejections under 35 U.S.C. § 103 are based. In particular, the attached Affidavit combined with Exhibits A and B show facts to establish reduction to practice of the invention before the effective date of the Montes reference.

As a preliminary matter before discussing the contents of the attachment, the Applicant respectfully requests the Examiner to note the guidance of M.P.E.P. § 715.07, Facts and Documentary Evidence under the sub-heading "Establishment of Dates." This

portion provides the following:

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

In view of the guidance provided by MPEP § 715.07, the Applicant respectfully suggests that the removal of dates from an exhibit to support an affidavit under 37 C.F.R. § 1.131 does not render the evidence submitted as insufficient when the oath or declaration relates to conception or reduction to practice, as in this particular case. Rather, the Examiner should still examine the body of the oath or declaration and consider whether the matter of dates has been taken care of by the content of the oath or declaration itself.

Moving now to the contents of the Affidavit, the Applicant requests the Examiner to consider numbered paragraph 5 of the Affidavit. In this paragraph, the Applicant states that "I submit herewith and attach hereto Exhibit A, which is a redacted photocopy of the Disclosure of Invention that I prepared and submitted before June 20, 2003, to the Patent Counsel of NASA Johnson Space Center located in Houston, Texas, and that was received therein before June 20, 2003. Exhibit A is a redacted photocopy because dates have been blocked off. All of the dates redacted in Exhibit A are before June 20, 2003." The Affidavit thus provides that the conception of the invention evidenced by Exhibit A occurred before June 20, 2003. Accordingly, the Applicant respectfully suggests that, although the dates contained in Exhibit A have been blocked off, the matter of dates has been taken care of in the body of the oath of the Affidavit. Following the guidance of MPEP § 715.07, the Examiner should consider the Affidavit sufficient to establish a

conception of the present invention in the United States before the effective date of the Montes reference.

Additionally, the Applicant draws the Examiner's specific attention to numbered paragraphs 7 and 8 of the Affidavit. In paragraph 7, the Applicant states that "I submit herewith and attach hereto Exhibit B, which is a photograph of a prototype of a device or system for analyzing microparticles in laminar flow through a chamber in accordance with the invention defined by claims 1, 2, 4-17, and 25-28 of the above-identified patent application. The photograph of Exhibit B was taken before June 20, 2003." In paragraph 8, the Applicant states "The system shown in Exhibit B was built, assembled, and tested for its intended purpose at the facilities of Filter Flow Technology, Inc., located at 122 Texas Avenue in League City, Texas, before June 20, 2003. This same system shown in Exhibit B also worked for its intended purpose of analyzing microparticles in laminar flow through a chamber before June 20, 2003." The Affidavit combined with Exhibit B provides evidence that reduction to practice of the invention occurred in the United States before June 20, 2003. The Applicant respectfully asserts that, although no date appears in Exhibit B, the matter of dates has been taken care of in the body of the oath of the Affidavit. Following the guidance of MPEP § 715.07, the Examiner should consider the Affidavit combined with Exhibits A and B as being sufficient to establish a reduction to practice of the invention given in claims 1, 2, 4-17, and 25-28 in the United States before the effective date of the Montes reference. In view of the evidence submitted, the Applicant respectfully requests the Examiner to reconsider and withdraw his previous rejection based on the Montes reference.

**2) Rejection Based on the Other References Cited by the Examiner:**

The Examiner's new ground of rejection of claims 1, 2, 4-17, and 25-28 presents two new hypothetical combinations of cited art: Montes and Schwartz, and Montes, Schwartz, and Ortyn. Because the Montes reference is the primary reference cited by the Examiner in support of the rejection under 35 U.S.C. § 103(a), the removal of the availability of Montes as a reference is fatal to the Examiner's new ground of rejection. Absent the Montes reference, the remaining references fail to establish a *prima facie* case

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of obviousness for independent claims 1, 10, and 25.

**CONCLUSION**

In view of the above Response, the Affidavit Under Rule 1.131, and the accompanying Exhibits, the Applicant submits that all pending claims in the instant application are in condition for allowance. The Applicant respectfully requests an early action to this end.

Respectfully submitted,

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